

Docket Number: 1034-01-PA
App. Ser. No. 09/650,045
Reply to Office action of June 19, 2006

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REMARKS/ARGUMENTS

Claims 279-285 are pending in this application, of which, claim 279 is independent. Applicants respectively request reconsideration of the patentability of the pending claims of the present application in view of the following remarks.

Rejections Under 35 U.S.C. § 103(a)

Claims 279-285 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the website www.igive.com (iGive.com) in view of U.S. Patent No. 5,806,045 to Biorge et al. Applicants respectfully traverse this rejection.

iGive.com and Biorge, by themselves or in combination, fail to disclose the elements of Claim 279. In particular, the references fail to disclose "receiving an arrangement". The office action states that iGive.com discloses "a computer implemented arrangement comprising the steps of receiving an arrangement (pages 4-5)" (See page 2 of the Office Action) Applicants respectfully disagree and assert that iGive.com does not disclose an "arrangement" as defined in Claim 279.

The arrangement in Claim 279 is the result of a user's search for a provider of a good, service, and information that is willing to share a user-provider-agreed portion of the proceeds of such transaction, or some other user-provider-agreed benefit, with, or to, the user-provider-agreed beneficiary. (See Pages 17-18, lines 12-25 and lines 16-25, respectively, of the present invention) After the user completes her search, the arrangement identifies (1) the user; (2) the good, service, and information to be acquired; (3) the provider; (4) the form of payment; (5) the identity of the beneficiary group(s); (6) the portion(s) of the proceeds or other benefit to be allocated to the beneficiary group(s), provider, and others (including one or more facilitators of the arrangement); and (7) authorization from the user to execute the arrangement by disposition of all benefits (i.e. consideration) as thus agreed upon. The complete business transaction is executed immediately, pursuant to the details of the arrangement.

Docket Number: 1034-01-PA
App. Ser. No. 09/650,045
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Pages 4-5 of iGive.com, relied on by the Office Action for disclosing an arrangement, disclose the background of iGive.com, along with information about the founder and the board members of iGive.com. Specifically iGive.com states:

“At iGive, we are dedicated to building an online community that harnesses the collective power of our members in order to aid worthwhile causes or charities. We’re using the Internet and massive computing power to create a simple, fast, individualized, and inexpensive connection between our members, their favorite worthy causes, and businesses seeking to benefit our members’ interests.”
(iGive.com page 4)

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This merely discloses that iGive.com has members and that a connection is made between the members, their favorite worthy causes, and businesses seeking to benefit the member's interests. Describing a connection between members, a worthy cause, and a business fails to disclose “receiving an arrangement” as defined in claim 279. Furthermore, iGive.com is a closed system that limits itself to transactions between its members and merchants (i.e. providers) previously associated with iGive.com and listed on the iGive.com mall. The present invention is an open system that sets no limits on the user, provider, or beneficiary, but allows the creation of an arrangement between and among a variety of such parties, even those previously unknown to each other, as the result of dynamic, “on the fly” searching, and spontaneous, dickered terms of the arrangement/business transaction.

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In view of the above, nowhere does iGive.com teach, suggest or disclose receiving an arrangement as defined in Claim 279. Becoming a member of iGive.com merely allows a user, to use iGive.com services to access iGive.com-registered merchants and earn credits to user's account for transactions concluded with such merchants and, subject to iGive.com determined rules and parameters, later to effect disposition of some of those credits to iGive.com registered charities.

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In addition to failing to disclose any arrangement overall, iGive.com also fails to disclose specific elements of the arrangement as defined in claim 279. First, contrary to the Office Action on page 4, iGive.com does not disclose “a payment to be made by the user to acquire the at least one good, service and information in the business transaction”.

Docket Number: 1034-01-PA
App. Ser. No. 09/650,045
Reply to Office action of June 19, 2006

Second, iGive.com does not disclose "a business transaction proceeds allocation allocating a portion of the proceeds to the at least one of a plurality of beneficiary groups". The present invention allocates a portion of the proceeds of the transaction to at least one beneficiary group, unlike iGive.com, which provides a rebate (or credits) to the member based on a commission determined by iGive.com. The rebate is collected by iGive.com and transferred to the member's account. "iGive.com uses its best efforts to collect the rebate from the iGive mall merchant and then remits the rebate to the members account for later disbursement to a selected nonprofit or to the member." (See Page 12, number 9)

Third, iGive.com does not disclose "causing a payment entity to distribute the proceeds of the business transaction to the provider and the at least one of a plurality of beneficiary groups" as defined in claim 279. The rebates (or credits) of iGive.com are distributed via iGive.com checks that are sent to the nonprofit organization that may (or may not be) selected by the member only when the member's account contains at least \$5. (See pages 38-39 of iGive.com) The rebate can only go to one charitable organization or to the member; it may not be divided between the provider, the beneficiary group, or beneficiary groups as defined in claim 279.

Fourth, contrary to the Office Action on page 4, iGive.com does not disclose "authorization from the user to effect the payment".

Fifth, iGive.com also fails to disclose, teach or suggest that the business transaction is executed by causing the delivery of the good, service and information, as defined in claim 279. As described above, iGive.com collects the rebate from the merchant and then transfers the rebate to the member's account; the rebate provided to the member's account is not related to delivering the good, service and information as in the present invention and defined in claim 279. Furthermore, in the present invention the proceeds go immediately and directly to the beneficiary and not to a member's account for later disbursement.

In summary, iGive.com does not disclose, teach or suggest, amongst other things, the following: (1) receiving an arrangement; (2) a payment to be made by the user to acquire the at least one good, service and information in the business transaction; (3) a business transaction proceeds allocation allocating a portion of the proceeds to the at least one of a plurality of beneficiary groups; (4) authorization from the user to effect the payment; and (5) that the business transaction is executed by causing the delivery of the good, service and information.

Docket Number: 1034-01-PA
App. Ser. No. 09/650,045
Reply to Office action of June 19, 2006

Please see the attached table which summarizes the major differences between iGive.com and the present invention.

No Motivation to Combine

5 Applicants respectfully submit that there is no motivation for one of ordinary skill in the art to combine the teachings of iGive.com with that of Biarge.

The Office Action relies on Biarge to show (1) a payment to be made by the user to acquire at least one good, service and information in the business transaction (col. 8, lines 39-41; col. 14, lines 23-42); and (2) authorization from the user to effect the payment (col. 8, lines 10 39-41; col. 14, lines 23-42). (See page 4 of Office Action) Column 8, lines 39-41 and column 14, lines 23-42, describe a customer-carried portable device (74) or card that can be used as a debit card or a credit card to complete the payment phase of a transaction. In other words, a card is used to pay for a transaction. A base device (72), provider device (76) and the customer device (74) comprise a customer incentive system. A customer receives incentive credits for entering 15 into a transaction with the base device or the provider device. The customer can redeem the incentive credits on another transaction. This is completely distinct from iGive.com which is directed to a member based on-line shopping system where a member can purchase items from a pre-determined list of merchants and receive a rebate from the purchase. Thus, it would not have been obvious to one of ordinary skill in the art to combine their teachings.

20 Further, in order to establish even a *prima facie* case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. The motivation, suggestion or teaching, may come explicitly from statements in prior art, the knowledge of one of ordinary skill in the art, or in some cases, the nature of the problem to be solved. See *In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999).
25 There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.

The Office Action states that the two references can be combined "in order to carry out the transaction (Biarge, col. 4, lines 7-8). However, lines 7-8 of column 4 actually state "Together, these two devices provide most of the information needed to carry out a transaction." 30 ("These two devices" refer to the customer device and the provider device. See column 4, lines 1-2.) As the statement "in order to carry out the transaction" is specifically related to the system

Docket Number: 1034-01-PA
App. Ser. No. 09/650,045
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SEP 19 2006

of Biurge, it fails to provide any motivation to combine iGive.com and Biurge as iGive.com does not utilize two devices as Biurge does. This is no way is relevant or analogous to iGive.com.

Therefore, Biurge fails to remove the deficiencies of iGive.com and hence the combination fails to disclose the elements of Claim 279.

5 Based on at least the foregoing reasons, Applicants respectfully submit that independent Claim 279 is patentably distinguishable over iGive.com and Biurge, either alone or in combination. Applicants respectfully request allowance of Claim 279.

CONCLUSION

10 In view of the above, Applicants respectfully request reconsideration of the patentability of independent claim 279 and claims 280-287 which depend therefrom. If the Examiner believes that a telephone conference with Applicants' representative might expedite prosecution of this application, she is cordially invited to call at the number listed below.

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Respectfully submitted,

Dated: 9/19/06

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**TABLE OF MAJOR DIFFERENCES BETWEEN
IGIVE.COM AND APPLICANT'S SYSTEM**

	<i>IGIVE.COM SYSTEM</i>	<i>APPLICANT'S SYSTEM</i>
1. System Medium of Communication	<i>Internet or Member Newsletter Only</i>	<i>Internet, any terminal, point of sale device, PDA and/or any communication system</i>
2. User/buyer/is	<i>Only a pre-registered, pre-qualified member</i>	<i>Anyone</i>
3. Provider/merchant/is	<i>Merchant affiliated and pre-registered with iGive mall</i>	<i>Any provider of a good, service and information world-wide</i>
4. Process begins with	<i>Merchant advertisement and pre-defined incentive rebate program</i>	<i>User search for goods/services/info</i>
5. Product/service/info	<i>Only advertised goods, services, information only</i>	<i>Any product/services/info</i>
6. Nature of transaction benefit	<p><i>Conditional deposit of incentive credit "Rebate" to User's account</i></p> <p><i>for later, conditional, transfer to User or System-Operator- "qualified entity" that User designates to redeem rebate credits</i></p>	<p><i>Cash or other agreed consideration</i></p> <p><i>for immediate transfer to any third party beneficiary agreed to by User and Merchant/Provider "on the fly" (during the course of their online exchanges)</i></p>
7. Conditions of benefit	<p><i>User account and minimum deposit/balance required for rebate transfer</i></p> <p><i>Minimum User account holding time for rebate transfer</i></p>	<p><i>No User account required; no minimum account deposit/balance required for benefit transfer to third party</i></p> <p><i>No minimum account holding time required for benefit transfer to third party; Benefit transfer is immediate upon closing of transaction</i></p>

<i>continued</i>	<i>IGIVE.COM SYSTEM</i>	<i>APPLICANT'S SYSTEM</i>
8. Transfer (allocation) may be made to	<i>Only to User, or "Qualified Entity"</i> -- entity qualified by System Operator	<i>Any third party beneficiary</i> agreed to by User and Merchant/Provider "on the fly" (during the course of their online bargaining - arrangement)
9. Amount of transfer (allocation)	<i>Pre-fixed rebate sum or pre-fixed percentage of transaction</i>	<i>Any sum or any percentage of transaction</i> agreed to by User and Merchant/Provider "on the fly" (during the course of their online bargaining - arrangement)
10. Overall Description of System	<i>A closed, rebate system in which a pre-registered User is required to purchase/procure minimum amount of pre-programmed, mall-advertised goods/services/information from a paying, pre-registered Merchant/Provider who advertises on the System Operator's website or newsletter</i>	<i>An open, third-party-benefit system in which any User may search for any amount of any goods/services/information from any Merchant/Provider and bargain with one or more such Merchant/Providers selected by the User 'on the fly' for</i> <i>continued on next page</i>

<u>10. Overall Description of System, continued</u>	IGIVE.COM SYSTEM	APPLICANT'S SYSTEM
	<p><i>only the advertised goods/services/info</i></p> <p><i>at the advertised price</i></p> <p><i>in order to enjoy the pre-programmed "rebate"</i></p> <p><i>to User's account with the System Operator</i></p> <p><i>for later disposition and upon required holding time and amount minima</i></p> <p><i>the account balance</i></p> <p><i>is transferred to User or to system-operator-Qualified Entity</i></p> <p><i>System Operator sets conditions, must act, to fulfill benefit</i></p>	<p><i>any goods/services/info agreed to by User and Merchant/Provider "on the fly"</i></p> <p><i>at any price agreed to by User and Merchant/Provider "on the fly"</i></p> <p><i>and secure</i></p> <p><i>the benefit, whatever its nature, agreed by User and Merchant/Provider on the fly</i></p> <p><i>to any third party beneficiary, agreed to by User and Merchant/Provider on the fly</i></p> <p><i>and immediately upon closing of the transaction,</i></p> <p><i>the benefit agreed to on the fly</i></p> <p><i>is transferred</i></p> <p><i>to any third party beneficiary agreed to by User and Merchant/Provider on the fly</i></p> <p><i>Arrangement is "self-executing"</i></p>
<u>11. Relationship between User, Merchant/Provider and System Operator</u>	<p>Agreement between System Operator and Merchant Provider is prerequisite to system usage by User.</p> <p>Agreement between User and Merchant/Provider is limited to pre-determined conditions</p>	<p>No such pre-agreement required</p> <p>User and Merchant/Provider construct arrangement; agree on all terms, on the fly.</p>